



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,862	06/18/2001	Jeffrey Ross Gray	CWEST.002A	2596

20995 7590 01/04/2005

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

CRAIG, DWIN M

ART UNIT	PAPER NUMBER
----------	--------------

2123

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/883,862

Applicant(s)

GRAY ET AL.

Examiner

Dwin M Craig

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-14, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 8, 9, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-4-2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1-18** have been presented for Examination.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because, *the drawings are informal*. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 2123

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Independent **Claims 1, 10, 13 and 14** and dependent **Claims 2, 3, 5, 6, 11, 12, 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bald et al. U.S. Patent 6,054,865** in view of **Marino et al. U.S. patent 4,490,799** and in further view of **Jasmin et al. U.S. Patent 4,293,923**.

3.1 As regards independent **Claims 1, 10, 13 and 14** the *Bald et al.* reference discloses a *hipot* tester used for electrical safety testing (**Figures 1 & 2, Col. 1 Lines 61-67, Col. 2 Lines 1-9**), a plurality of input output terminals for connection to a tester (**Figures 1 & 2**), a first path comprising a high voltage input from a first of said plurality of terminals (**Figure 3 Items 11, 12 and 68 note the label, "HIGH VOLTAGE CONTROL BOARD"**), a first switch (**Figure 6 Item 54**), and an indication that a test either passed or failed (**Col. 10 Lines 38-50**).

However, the *Bald et al.* reference does not expressly disclose an air gap device or a simulator.

The *Marino et al.* reference discloses an air gap device used in a tester, designed to "*arc over*" at a specific high-level voltage (**Col. 7 Lines 23-50**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have provided for a method to perform "*air gap*" tests, as disclosed in the *Marino et al.* reference because, an "*air gap*" test is a geed method of determining the effectiveness of an insulated conductor.

The *Jasmin et al.* reference discloses an electrical simulator (**Col. 1 Lines 1-43**).

Art Unit: 2123

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have created a simulator in order to test the functionality of the electrical safety testing device as it is disclosed in the *Bald et al.* reference.

3.2 As regards dependent **Claims 2, 3, 17 and 18** the *Bald et al.* reference discloses switches and second and third circuit paths (**Figure 3**).

3.3 As regards dependent **Claim 5** the *Bald et al.* reference does not expressly disclose a spark plug.

The *Marino et al.* reference discloses a “*spark plug*” (**Abstract**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have used a spark plug as an “*air gap*” testing device because, spark plugs are low cost devices that provide an air gap arc over.

3.4 As regards dependent **Claim 6** the *Bald et al.* reference discloses a portable device (**Figure 1**).

3.5 As regards dependent **Claims 11 & 12** the *Bald et al.* reference discloses PASS and FAIL indicators (**Col. 10 Lines 38-50**).

Allowable Subject Matter

4. Dependent **Claims 4, 7, 8, 9, 15 and 16** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. **Claims 1-18** have been presented for Examination. Claims **4, 7, 8, 9, 15 and 16** are objected to. Independent **Claims 1, 10, 13 and 14** and dependent **Claims 2, 3, 5, 6, 11, 12, 17 and 18** are rejected. This Office Action is made **Non-Final**.


5.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 3,287,635 discloses an electrical discharge simulator (**Col. 1 Lines 12-30**).

5.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M Craig whose telephone number is (571) 272-3710. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (571)272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-308-1396.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMC



KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER